

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CHRISTOPHER B. FARMER

Appeal No. 2002-0637
Application 08/974,545

ON BRIEF

MAILED

JAN 21 2004

**PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES**

Before KRASS, FLEMING, and BARRY, Administrative Patent Judges.

FLEMING, Administrative Patent Judge.

REMAND TO EXAMINER

We remand this application to the Examiner for a consideration of the following matters. On page 2 of the final Examiner's action, the Examiner set forth the rejection of claims 16 and 17 under 35 U.S.C. § 102 as being anticipated by Sangveraphunsiri. The Examiner set forth the rejection

as follows: "with respect to claims 16 and 17, Sangveraphunsiri discloses the method steps as claimed (see for example Figures 21 and 22)."

On page 7 of the Appellant's brief, Appellant points out that claim 16 requires "inserting the edge connector of said processor in a connector on said motherboard, said processor having an orientation parallel" Appellant argues that Sangveraphunsiri illustrates in Figures 21 and 22 inserting the modular in a bay of a disk drive which has connector thereon. Appellant argues that the connector is not "on said motherboard." Appellant further argues that the connector shown in Figure 20 of Sangveraphunsiri is not parallel to the processor. Appellant argues that Sangveraphunsiri does not anticipate claim 16 nor 17 dependent thereon.

On page 4 of the Examiner's answer, the Examiner restates the sentence set forth in the final action. However, the Examiner has not provided us with a record establishing exactly what elements in Sangveraphunsiri are being relied upon to read on Appellant's claimed language. On page 9 of the Examiner's answer in the response to argument, the Examiner does state that

in Figures 21 and 22 of Sangveraphunsiri shows a mount (562) to receive a cartridge processor (520) having an edge connector and a motherboard (104) having a connector (548'). From these statements, it appears that the Examiner is relying on connector (548') as a teaching to anticipate "a connector on said motherboard."

On page 4 of the reply brief, Appellant argues that the words, on the motherboard, are easily understood and do not mean on a bay which then is plugged into the motherboard. Appellant argues that the claim language "inserting the edge connector of said processor in a connector on the motherboard said processor having an orientation parallel to and displaced from the motherboard" does not read on Sangveraphunsiri's inserting an edge connector of the processor in a connector in a bay, coupling the one end of the ribbon connector to the bay connector and plugging the other end of the ribbon connector into a connector on the motherboard.

In an Examiner's reply answer, mailed October 2, 2001, the Examiner is interpreting motherboard connector as claimed by applicant as reading on Sangveraphunsiri's elements 548', 568 and

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566 as shown in Figure 21. In other words, the Examiner is interpreting the claimed language "a connector on said motherboard" as recited in Appellant's claim 16 as a connector on the motherboard a ribbon connector and a connector on the bay.

37 CFR § 1.193(b)(1)(July 1, 2001) as amended at 6 FR 53197 (October 10, 1997), which was controlling at the time of the Examiner's filing of the Examiner's reply answer, states:

The primary Examiner must either acknowledge receipt and entry of the reply brief or withdraw the final rejection and reopen prosecution to respond to the reply brief. A supplemental Examiner's answer is not permitted, unless the application has been remanded to the Board of Patent Appeals and Interferences for such purposes.

Thus, the Examiner's reply answer is not permitted and the Examiner is directed to remove the Examiner's reply answer from the record.

We strongly recommend that the Examiner withdraw the final rejection and reopen prosecution and start anew in this case. The record needs to be clarified as to the scope of the claim elements as well as how the prior art references read on these claimed elements.

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As our reviewing court states, "[T]he terms used in the claims bear a "heavy presumption" that they mean what they say and have the ordinary meaning that would be attributed to those words by person skilled in the relevant art." **Tex Digital Sys, Inc. v. Telegenix, Inc.**, 308 F.3d 1193, 1202, 64 USPQ2d 1812, 1817 (Fed. Cir. 2002).

"Moreover, the intrinsic record also must be examined in every case to determine whether the presumption of ordinary and customary meaning is rebutted." (Citation omitted). "Indeed, the intrinsic record may show that the specification uses the words in a manner clearly inconsistent with the ordinary meaning reflected, for example, in a dictionary definition. In such a case, the inconsistent dictionary definition must be rejected." **Texas Digital Systems, Inc. v. Telegenix, Inc.**, 308 F.3d 1193, 1204, 64 USPQ2d 1812, 1819 (Fed. Cir. 2002). ("[A] common meaning, such as one expressed in a relevant dictionary, that flies in the face of the patent disclosure is undeserving of fealty."); **Texas Digital Systems, Inc. v. Telegenix, Inc.**, 308 F.3d at 1204, 64 USPQ2d at 1819 (Fed. Cir. 2002) (citing **Liebscher v. Boothroyd**, 258 F.2d 948, 951, 119 USPQ 133, 135 (CCPA 1958) ("Indiscriminate reliance on definitions found in

dictionaries can often produce absurd results.")). "In short, the presumption in favor of a dictionary definition will be overcome where the patentee, acting as his or her own lexicographer, has clearly set forth an explicit definition of the term different from its ordinary meaning." *Id.* at *6. "Further, the presumption also will be rebutted if the inventor has disavowed or disclaimed scope of coverage, by using words or expressions of manifest exclusion or restriction, representing a clear disavowal of claim scope." *Id.* at *6.

In particular, the Examiner should make the record clear as to the proper scope of the claim language "a connector on said motherboard" as found in Appellant's claim 16. Similarly, the Examiner should also make the record clear as to how "a motherboard connector" found in Appellant's claim 1 is interpreted.

Furthermore, our reviewing court requires that "The Board's findings must extend to all material facts and must be documented on the record, lest the 'haze of so-called expertise' acquire insulation from accountability. *In re Lee*, 61 USPQ2d 1430, 1435 (Fed. Cir. 2002).

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It is axiomatic that anticipation of a claim under § 102 can be found only if the prior art reference discloses every element of the claim. **See In re King**, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986) and **Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.**, 730 F.3d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984). "Anticipation is established only when a single prior art reference discloses, expressly or under principles of inherency, each and every element of a claimed invention." **RCA Corp. v. Applied Digital Data Sys, Inc.**, 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.), cert. dismissed, 468 U.S. 1228 (1984), citing **Kalman v. Kimberly-Clark Corp.**, 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983).

It is the burden of the Examiner to establish that each and every element of the claimed invention is anticipated by the reference. We request that the Examiner clearly point out how each of the claim limitations is met by the reference in a one-to-one correspondence. For each claim limitation, the Examiner must point to specific portions of the reference on which the Examiner has relied on to meet that limitation. It is the Examiner's duty to make pertinent and specific factual findings, including scope of the claim as well as the content of the prior art. On remand,

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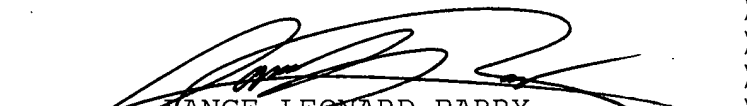
the record needs to be clarified as to Examiner's position on how the claimed subject matter is met by the prior art.

This application, by virtue of its "special" status, requires immediate action, see MPEP § 708.01(d). Further, it is important that the Board of Patent Appeals and Interferences be promptly informed of any action affecting the appeal in this case.

REMAND


ERROL A. KRASS
Administrative Patent Judge


MICHAEL R. FLEMING
Administrative Patent Judge


LANCE LEONARD BARRY
Administrative Patent Judge

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